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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,330	05/18/2006	Rune Freyer	2006-IP-019699 U1 USA	1607
49431 7590 08/07/2008 SMITH IP SERVICES, P.C. P.O. Box 997 Rockwall, TX 75087				
EXAMINER ANDREWS, DAVID L				
ART UNIT		PAPER NUMBER		
3672				
MAIL DATE		DELIVERY MODE		
08/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,330

**Applicant(s)**

FREYER, RUNE

**Examiner**

David Andrews

**Art Unit**

3672

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 6/4/2008 has been entered.

#### ***Response to Arguments***

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection. However, insofar as applicants general arguments against the combination of Lembcke et al. with other packer materials still apply, the examiner is not persuaded since it has been held that combining prior art elements according to known methods (or the simple substitution of one known element for another) to yield predictable results is supportive of a conclusion of obviousness (MPEP 2141 III).

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6-8, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. (US 6,173,788) in view of Laflin et al. (US 4,137,970). Lembcke et al. disclose a cable duct device in a swellable packer comprising: a swellable packer (12) of the kind in which the packer is adapted for sealing an annulus; at least one through going opening (14) adapted to constitute a duct for a cable (16); wherein the opening encloses the cable prior to and after the swelling has occurred (col. 2, lines 51-54); wherein the opening may variable longitudinal extension or variable

cross-section (these features are considered obvious over the disclosure of Lembcke since one of ordinary skill in the art being enabled to produce the device of Lembcke would also be enabled to provide the opening as any dimensions a particular application may require); a slit (18, 20 fig 2) extending through a sidewall of the packer; a cable positioned in the packer proximate the slit (16 fig 2); wherein the packer seals about the cable when the seal material swells (col. 2, lines 58-60); wherein the packer is annular and extends lengthwise in a longitudinal direction (fig 3a) and the slit and cable extend similarly (fig 3a); wherein the slit intersects an opening extending longitudinally through the packer and wherein the cable is positioned in the opening (fig 2). Lembcke et al. also disclose a method of extending a cable longitudinally through a packer comprising: providing a swellable packer including a seal material having an opening extending longitudinally through the seal material, and a longitudinal slit extending between the opening and an external surface of the packer and inserting a cable through the slit (fig 1) and swelling the seal to cause the seal to seal about the cable in the opening (fig 2). Lembcke et al. do not disclose the seal material as swelling and increasing in volume in response to contact with a swell-activating material. Laflin et al. disclose a packer including a seal material which swells and thereby increases in volume in response to contact with a swell-activating material (col. 3, lines 16-19) wherein the swell activating material comprises water (col. 3, lines 56-62). It would have been obvious to one of ordinary skill in the art at the time of invention to replace the seal of Lembcke et al. with the swellable material of Laflin et al. since the Laflin et al. suggest such a substitution (col. 3, lines 63+) and it has been held that the substitution of a known element for

another to obtain predictable results is obvious to one of ordinary skill (See MPEP 2141 III).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. (US 6,173,788) in view of Freyer (WO 02/20941). Lembcke et al. disclose a method of extending a cable longitudinally through a packer comprising: providing a swellable packer including a seal material having an opening extending longitudinally through the seal material, and a longitudinal slit extending between the opening and an external surface of the packer and inserting a cable through the slit (fig 1) and swelling the seal to cause the seal to seal about the cable in the opening (fig 2). Lembcke et al. do not disclose the seal material as swelling and increasing in volume in response to contact with a swell-activating material, wherein the material comprises hydrocarbons. Freyer discloses a packer material which swells by absorption of hydrocarbons to form an annular wellbore seal (abstract). It would have been obvious at the time of invention to substitute the hydrocarbon absorbing packer material of Freyer for the packer material of Lembcke et al. to arrive at the instant invention since the simply substitution of one known element for another to obtain predictable results has been held as obvious to one of ordinary skill (see MPEP 2141, exemplary rationale B).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Andrews whose telephone number is (571)272-6558. The examiner can normally be reached on Monday-Thursday, 7:30am-5pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Bagnell/  
Supervisory Patent Examiner, Art Unit 3672

DLA  
7/30/08